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PATENT APPLICATION

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Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 60004035-3IN THE
UNITED STATES PATENT AND TRADEMARK OFFICEInventor(s): L. Chiarabini
Application No.: 09/925,519
Filing Date: 08/10/01Confirmation No.: 4981
Examiner: James H. Zurita
Group Art Unit: 3625

Title: Method and Apparatus for Automated On-Line Printing Service

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 6/05/2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Inventorship L. Chiarabini
Assignee..... Hewlett-Packard Company
Group Art Unit..... 3625
Examiner James H. Zurita
Attorney's Docket No. 60004035-3
Title: Method And Apparatus For Automated On-Line Printing Service

APPEAL BRIEF

To: Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

From: Michael K. Colby
Hewlett-Packard Company
Intellectual Property Administration
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Pursuant to 37 C.F.R. §41.37, Applicant hereby submits an appeal brief for application 09/925,519, filed August 10, 2001, within the requisite time from the date of filing the Notice of Appeal. Accordingly, Applicant appeals to the Board of Patent Appeals and Interferences seeking review of the Examiner's rejections.

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(1) Real Party in Interest

The real party in interest is Hewlett-Packard Company, the assignee of all right, title, and interest in and to the subject invention.

(2) Related Appeals and Interferences

Appellant is not aware of any other appeals, interferences, or judicial proceedings that will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision to this pending appeal.

(3) Status of Claims

Claims 10 and 27-30 stand rejected and are pending in the Application. Claims 31-38 stand withdrawn. Claims 10 and 27-38 are set forth in the Appendix of Appealed Claims on page 26.

(4) Status of Amendments

A Response to the final Office Action mailed January 3, 2006 was filed on February 27, 2006. The Response amended one claim that was rejected under 35 U.S.C. §112. An advisory action was mailed on March 29, 2006, advising Applicant that the Response and corresponding amendment were not entered. Applicant filed a Notice of Appeal on June 5, 2006.

(5) Summary of Claimed Subject Matter

A concise explanation of each of the independent claims is included in this Summary section, including specific reference characters, if any. These specific

reference characters are examples of particular elements of the drawings for certain embodiments of the claimed subject matter and the claims are not limited to solely the elements corresponding to these reference characters. Similarly, specific reference to the specification exemplifies the subject matter, although other portions of the specification may also support and describe the claims.

Claim 10 describes a method of providing on-line print services, said method comprising the steps of: receiving at least one order for print products on-line (Page 13, line 14 through Page 14, line 2; Page 14, lines 14-28; Page 16, lines 1-14; Page 17, lines 4-13; Page 17, lines 27-29), said at least one order having an item requiring a particular sheet material (Page 19, lines 15-17); electronically distributing said at least one order to at least one print service provider facility (Page 13, line 30 through Page 14, line 14); within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device (Page 17, line 15 through Page 18, line 22; Page 19, line 11 through Page 22, line 9; Figs. 10 and 11 (1003)); and printing said item according to said order, with said printer device, and on said particular sheet material (Page 17, lines 4-13).

Claim 31 describes a method of providing on-line print services, said method comprising the steps of: receiving at least one order for print products on-line (Page 13, line 14 through Page 14, line 2; Page 14, lines 14-28; Page 16, lines 1-14; Page 17, lines 4-13; Page 17, lines 27-29), said at least one order having an item requiring a particular ink type (Page 18, line 24 through Page 19, line 1; Page 19, lines 15-18); electronically distributing said at least one order to at least one print service provider facility (Page 13, line 30 through Page 14, line 14); within a

said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular ink type loaded onto said printer device (Page 17, line 15 through Page 22, line 9; Figs 10 and 11 (1003)); and printing said item according to said order, with said printer device, and using said particular ink type (Page 17, lines 4-13).

Claim 36 describes a method of providing on-line print services, said method comprising the steps of: receiving at least one order for print products on-line (Page 13, line 14 through Page 14, line 2; Page 14, lines 14-28; Page 16, lines 1-14; Page 17, lines 4-13; Page 17, lines 27-29); electronically distributing said at least one order to at least one print service provider facility (Page 13, line 30 through Page 14, line 14); within a said print service provider facility, electronically allocating said order to at least one printer device (Page 17, line 15 through Page 22, line 9); printing a print item according to said order (Page 17, lines 4-13); electronically arranging a plurality of virtual print items on at least one virtual media sheet (Page 22, line 11 through Page 23, line 11; Fig 14 (1400-1408)); and re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet (Page 23, lines 8-22; Fig. 14 (1406-1410)).

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 10 and 28-30 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 2003/0140315 to Blumberg et al. (hereinafter "Blumberg").

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in light of Official Notice.

Finally, claims 31-38 stand withdrawn as being drawn to a non-elected invention.

(7) Argument

A. The rejections under 35 U.S.C. §102(e) fail to establish that Blumberg anticipates the claims against which it is cited.

Applicant respectfully submits that the Office has not established that the claims rejected under 35 U.S.C. §102(e) are anticipated by Blumberg. The discussion first includes a section entitled “The §102 Standard”, which describes the standard by which claim anticipation is established. Next, a section entitled “The Blumberg Reference” describes salient aspects of Blumberg’s disclosure. Finally, a section entitled “The Claims” presents Applicant’s reasoning as to why the Office has not established that Blumberg anticipates the rejected claims.

The §102 Standard

Applicant notes the requirements of MPEP §2131, which states that to anticipate a claim, the reference must teach “every element” of the claim. This section further states that:

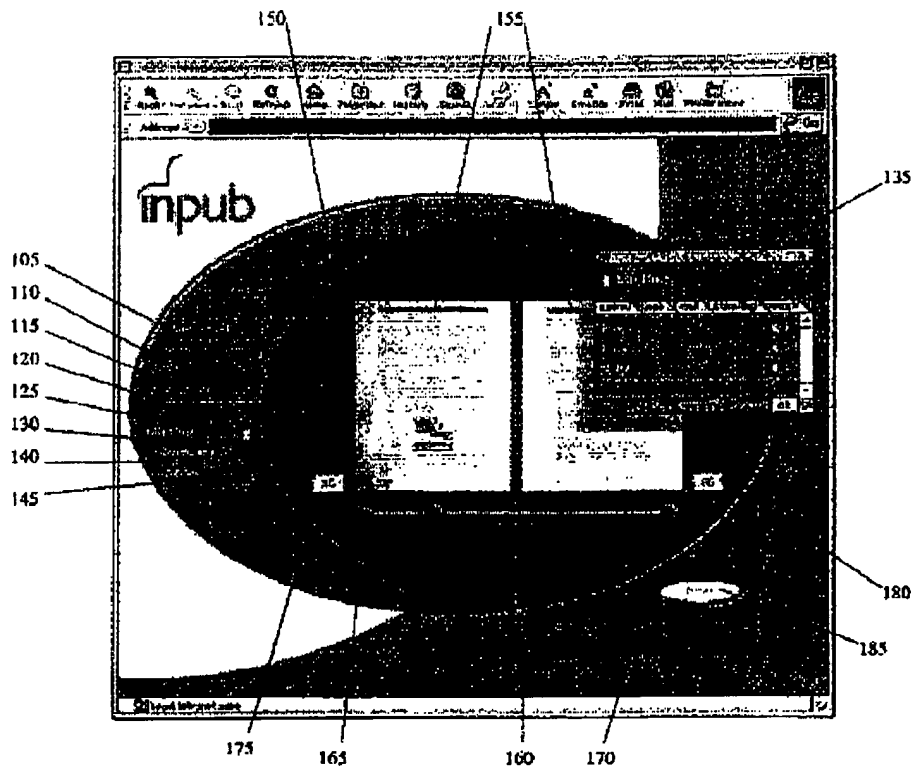
“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the

claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Accordingly, the reference must contain, within its four corners, exactly the subject matter of the claim, as it appears in the claim, in order to support a valid finding of anticipation. The absence from a cited §102 reference of *any* claimed element negates a finding of anticipation. See, e.g., Kloster Speedsteel AB, et al. v. Crucible, Inc., et al., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The Blumberg Reference

Blumberg describes a method for creating and viewing, on a computer monitor, content to be printed. The method includes receiving an electronic document, selecting finishing options for the electronic document, and displaying how the electronic document would appear as a finished document, if printed in accordance with the finishing options. Blumberg's Figure 1, which appears on the face of the publication, depicts the user interface of the disclosed "Virtual Builder" viewer software and is displayed below. Blumberg also describes an on-line on-demand printing service. After a user has created a print job with the Virtual Builder software, shown below, the user may order print jobs via a computer network.



The Claims

Claim 10

Claim 10 recites a method of providing on-line print services, said method comprising the steps of:

- receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;
- electronically distributing said at least one order to at least one print service provider facility;
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and
- printing said item according to said order, with said printer device, and on said particular sheet material.

In making out a rejection of claim 10, the Office states that Blumberg discloses all of the subject matter of the claim, including “electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device”. In particular, the Office states that “Blumberg discloses allocating an item to a printer device based on said printer device having[] said particular sheet material loaded on said printer device. See paragraph[s] 105, 172, for printer devices that print on materials such as clay (mugs), [and] cloth (t-shirts).” (*Office Action of 01/03/06*, p. 6-7). Applicant respectfully but strongly disagrees with the rejection.

Applicant respectfully submits that the Office fails to state a *prima facie* case of anticipation, as the cited portions of Blumberg fail to disclose all of the elements of Applicant’s claim. For example, Applicant strongly submits that the Office fails to show how Blumberg discloses “electronically *allocating said item to a printer device* based on said printer device having said *particular sheet material loaded* on said printer device”, as recited in claim 10. (emphasis added). In claiming that Blumberg discloses this element, the Office cites Blumberg’s paragraphs 105 and 172. Both paragraphs are reproduced below (emphasis added):

[0105] In a preferred embodiment of the present invention, Virtual Builder invokes different *user interfaces* for different modes of operation, such as standard documents, brochures, business cards, letterheads and mugs.

* * *

[0172]It should be apparent to those skilled in the art that other specialized *display engines* can be added as necessary for other types of products, such as glossy marketing and advertising materials, t-shirts, mugs and mouse pads.

As the emphasized portions illustrate, the above-cited text does disclose “allocating [an] item to a printer device”, nor does it disclose a “printer device” at all. Instead, these passages relate to the Virtual Builder *software* of Blumberg, which allows products to be *viewed on a monitor*. According to these passages, this software may include “different user interfaces” or “specialized display engines”. Applicant respectfully submits that Blumberg cannot be shown to disclose “allocating [an] item to a printer device” when the cited passages make *no mention of a printer device*.

Furthermore, as these passages fail to disclose “allocating [an] item to a printer device”, they accordingly fail to disclose “electronically allocating said item to a printer device based on said printer device having said *particular sheet material loaded* on said printer device”. While the Office appears to rely on “clay” and “cloth” as the claimed “material”, Applicant submits that the cited passages fail to show where these mugs and t-shirts are “*loaded* on [a] printer device”. Instead, the passages discuss a specialized display engine that may be configured to view—on a computer monitor—products such as t-shirts or mugs.

Furthermore, the absence of a “loaded” printer device results in the absence of any disclosure concerning the logic recited in the step, namely “electronically *allocating* said item to a printer device *based on* said printer device *having said particular sheet material loaded* on said printer device”. However, this infirmity

is superfluous as the passages fail to disclose any sort of “printer device” at all, as discussed above.

In sum, Applicant respectfully submits that the Office’s rejection fails to show how Blumberg discloses the elements present in Applicant’s claim 10, and also fails to show how Blumberg discloses the logic recited in the step, which requires “electronically *allocating* said item to a printer device *based on* said printer device *having said particular sheet material loaded* on said printer device”.

For at least these reasons, Applicant respectfully submits that the Office fails to state a *prima facie* case of anticipation. Applicant therefore requests the withdrawal of the rejection of claim 10.

Claims 28-30 depend from claim 10, and the rejections of these claims is improper for at least the reasons discussed above in regards in their base claim. In addition, these claims recite features that are not disclosed by the cited portions of Blumberg.

Claim 28

Claim 28 recites a method as claimed in claim 10, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material.

In making out a rejection of this claim, the Office first states that Blumberg discloses “targeting to [a] specific output device such as a color printer”, and directs Applicant to Paragraph 132. This passage is reproduced below.

[0132] Color management is becoming increasingly accurate for matching colors produced on a video display with colors produced by an output device such as a color printer. The International Color Consortium (ICC) has introduced ICC profiles, used to transform

device-dependent colors from one device to another. When an ICC profile is provided for a specific color space, multiple devices can accurately convert color from the specific color space to native device color spaces. Information about ICC profiles is available on the Web, at <http://www.color.org>. Adobe Acrobat 4 supports ICC profiles embedded within PDF documents.

Applicant respectfully submits that this brief tutorial on color printing fails to relate to “electronically distributing [] based on said at least one print service provider facility being capable of printing on said *particular sheet material*” as recited in Applicant’s claim 28. (emphasis added). Assuming, without conceding, that the Office is correct in stating that Blumberg discloses “targeting to [a] specific output device such as a color printer”, Applicant submits that such color capabilities of the targeted device are unrelated to the device’s ability to print on a “particular sheet material”. As such, the Office fails to show this element of Applicant’s claim 29.

Furthermore, Applicant respectfully submits that the two other cited passages of Blumberg stray even further from Applicant’s claimed subject matter than the passage addressed immediately above. Both passages are reproduced below (emphasis added).

[0009] The present invention provides an on-line on-demand printing service that enables a user to interactively create and view a finished document, such as a bound book, an eight-page brochure or a customized business card. A user using the present invention can see on his video monitor how a document will look as a finished document, with selected front and back covers, selected binding, selected inserts, selected paper type, size and grain, selected imposition, selected folding, *selected lamination*, selected hole punching, and other selected finishing options. A user using the present invention can also see on his video monitor how a printed product such as a business card will look as a finished document with his own name, company address and logo inserted.

* * *

[0172] It should be apparent to those skilled in the art that other specialized *display engines* can be added as necessary for other types of products, such as glossy marketing and advertising materials, t-shirts, mugs and mouse pads.

Addressing the paragraphs in order, it appears from the Office's reference to "lamination" in the Office Action that this is the portion of paragraph 9 which the Office believes discloses Applicant's claim. Applicant respectfully submits, however, that lamination is not a "particular sheet material", but rather a finishing process that may be done upon a sheet material. The cited portion of Blumberg thus fails to disclose the additional element recited in claim 29.

As for paragraph 172—which Applicant previously addressed above in regards to claim 10—Applicant once more submits this passage only relates to "display engines", which function on a user's computer monitor and do not relate to "electronically allocating" to a "print service provider facility being capable of printing on said particular sheet material".

For at least these additional reasons, Applicant submits that the Office fails to show how Blumberg discloses "wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material." Applicant thus respectfully requests that the rejection of claim 28 be withdrawn.

Claim 29

Claim 29 recites a method as claimed in claim 10, further comprising

- electronically arranging a plurality of virtual print items on at least one virtual media sheet; and
- re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

In making out a rejection of this claim, the Office states that Blumberg discloses all of the elements of this claim. Specifically, the Office instructs Applicant to “[s]ee for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.” (*Office Action of 01/03/06*, p. 7-8). Applicant traverses the rejection.

Applicant strongly submits that the Office fails to state a *prima facie* case of anticipation, as the passages cited by the Office fail to disclose the elements of claim 29. With due respect to the Office’s viewpoint, Applicant submits that the first cited passage of Blumberg, paragraph 96, does not address essential elements of Applicant’s claim. This passage is reproduced entirely below:

[0096] To distinguish between selection of a page and selection of a side of a page, the page properties pop-up sheet has two sections. "Side" properties relate to selected sides, and "page" properties related to both the front and back sides of a selected page, regardless of whether one or two sides are selected. When a user selects a page, he can edit the actual media (i.e., the paper) itself, or the printing on a side (i.e., a face) of the page. Media edit options include modification of paper type and lamination, which apply to both sides of a page. Side options include the printing process, such as black & white vs. color reproduction, or the application of a gloss coat in

high-end printing, or scaling of text and graphics, which may be different on the front and back sides of a page.

Applicant submits that the cited passage merely describes “edit options” for Blumberg’s Virtual Builder software, from which a user may modify the document on the user’s computer monitor. Applicant respectfully submits that this passage fails to relate to the subject matter of Applicant’s claim, namely “electronically *arranging a plurality of virtual print items* on at least one virtual media sheet” and “*re-sorting* said plurality of virtual print items amongst said at least one virtual media sheet in a manner which *minimizes a number of cuts*”. If the Office disagrees, then Applicant respectfully requests that the Office point out which particular part of Blumberg’s paragraph 96 relates to the elements of Applicant’s claim.

Applicant further submits that the second portion of Blumberg cited by the Office is equally unavailing. Although the Office does not cite to a particular paragraph, the “eight-page booklet” to which the Office refers only appears in paragraphs 9, 40 and 102. Each paragraph is reproduced below (emphasis added):

[0009] The present invention provides an on-line on-demand printing service that enables a user to *interactively create and view* a finished document, such as a bound book, an *eight-page brochure* or a customized business card. A user using the present invention can *see on his video monitor how a document will look* as a finished document, with selected front and back covers, selected binding, selected inserts, selected paper type, size and grain, selected imposition, selected folding, selected lamination, selected hole punching, and other selected finishing options. A user using the present invention can also see on his video monitor how a printed product such as a business card will look as a finished document with his own name, company address and logo inserted.

* * *

[0040] The Internet print on demand service of the present invention also uses finished document *templates that enable a user to view, customize and order personalized printing products*, such as stationary, envelopes, business cards, calendars, greeting cards and invitations. A template includes a pre-constructed set of finishing options that are to be applied to a document. Templates are also used for *creating and ordering types of products having styles that a printing company has pre-designed, such as* folders, flyers, four-page glossy brochures, *eight-page brochures* with cut-outs and inserts, and sixteen-page booklets.

* * *

[0102] Preferably, the library of available styles is based on a selected print facility, since different print facilities typically offer different selections of styles. Use of templates enables a user to create documents with sophisticated styles, without having to create the style himself. In addition, the styles of templates are preferably designed in such a way that they conform to printing and folding operations that are easy to implement. For example, *an eight-page booklet can be produced by printing on a single large page that is folded in half three times*, cutting appropriate folds and stapling twice in the center. In distinction, when a user designs his own style of document, it may be complicated to produce.

Applicant submits that all of the above passages fail to disclose Applicant's claim. At most, these passages of Blumberg disclose that an eight-page brochure may be created by a Virtual Builder user, viewed on the user's computer monitor, ordered by the user, and produced by printing on and folding a page three times. Even assuming that the Blumberg template discloses "electronically arranging a plurality of virtual print items on at least one virtual media sheet", which it does not, nothing in the passage discloses "*re-sorting* said plurality of virtual print items". Again, if the Office disagrees, Applicant respectfully requests that the

Office point out with more particularity which part of the cited text discloses this element.

Furthermore, while the Office appears to principally rely on the emphasized text of paragraph 102, Applicant submits that this language does not disclose “*re-sorting*”, and certainly does not disclose “re-sorting said plurality of virtual print items *in a manner which minimizes a number of cuts*”. Instead, Blumberg discloses one way in which an eight-page booklet can be produced—namely printing on a large page and folding it three times. Blumberg does not “re-sort”, nor evince a concern for arranging the booklet so as to “minimize a number of cuts”. Instead, Blumberg intends to give the Virtual Builder software user the ability to create a booklet in a way which is “easy to implement”.

For at least these reasons, the Office fails to state a *prima facie* case of anticipation. Applicant therefore requests the withdrawal of the rejection of claim 29.

Claims 31-38

Claims 31-38 stand withdrawn as being drawn to a non-elected invention. Applicant therefore notes that because the Office has refused to examine these claims, claims 31-38 *have not* been rejected. Nevertheless, Applicant submits that a rejection of independent claims 31 and 36 based on reasons similar to claims 10 and 29, respectively, would be improper for at least the reasons discussed above in regards to claims 10 and 29. In other words, if such a rejection of claim 31 *were* to exist, it would be improper as at least failing to show how Blumberg discloses “electronically allocating said item to a printer device based on said printer device

having said particular ink type loaded onto said printer device". Similarly, any rejection of claim 36 for reasons similar to that given in claim 29 would be improper, as Blumberg fails to disclose "re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet." As claims 32-35 and 37-38 depend upon claims 31 and 36, respectively, any rejection of these dependent claims would be equally improper for at least these reasons.

B. The rejections under 35 U.S.C. §103(a) fail to establish that Blumberg in view of Official Notice renders claim 27 obvious.

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in view of Official Notice. Claim 27, however, depends from claim 10. Because the "Official Notice" does not cure the deficiencies of the rejection of claim 10, the rejection of claim 27 is improper for least the reasons discussed above in regards to the base claim. Furthermore, claim 27 recites features that are not properly disclosed by the cited portions of Blumberg or by proper Official Notice.

C. The Office's withdrawal of claims 31-38 is improper, as all claims read upon the invention elected in response to the Office's election/restriction requirement of March 15, 2005.

In the Office Action mailed January 3, 2006, the Office withdrew newly-added claims 31-38 under 35 U.S.C §1.145, stating that these claims are "directed to a non-elected invention." (*Office Action of 01/03/06*, p. 3) (note that while the Office cites to 35 U.S.C §1.142(b), Applicant assumes that the Office intends

§1.145). Applicant respectfully submits that all claims read upon the *two-claim* invention elected in response to the Office's *23-way* election/restriction of Applicant's original 26 claims.

Claim 31

Claim 31 recites a method of providing on-line print services, said method comprising the steps of:

- receiving at least one order for print products on-line, said at least one order having an item requiring a particular ink type;
- electronically distributing said at least one order to at least one print service provider facility;
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular ink type loaded onto said printer device; and
- printing said item according to said order, with said printer device, and using said particular ink type.

As depicted below in a reproduced portion of the Office Action, it appears that the Office believes that the inclusion of "*ink type*" in independent claim 31 renders the claim restricted and/or non-elected.

As to claims 31-38, these claims remain withdrawn by original presentation as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The claims recite specific features such as:

- receiving at least one order for print products on-line, said at least one order having an item requiring a particular ink type (claim 31)
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular ink type loaded onto said printer device; (claim 31)
- printing said item according to said order, with said printer device, and using said particular ink type. (claim 31)

(Office Action of 01/03/06, p. 3-4). Applicant respectfully disagrees with the Office's assertion that Claim 31 does not read upon the elected invention. Applicant submits instead that all claims 31-35 clearly direct to an elected group.

Applicant submits that claim 31 is indeed directed to an elected group. However, a proper understanding of the claimed subject matter as well as the prosecution history of this application is necessary to fully understand this assertion.

In the Office's first Action on the current case, the Office remarkably restricted the current application to no fewer than 23 different groups. (Office Action of 03/15/05). For comparison purposes, the application as filed contained only 26 claims. Applicant properly traversed the restriction, but nevertheless elected to prosecute species b of Group III. Species b of Group III, as grouped by the Office, contained only *two claims of the originally filed application, namely claims 10 and 12*.

Original claim 12 recited a method as claimed in claim 10, further comprising (emphasis added):

- allocating a plurality of said print items to a plurality of printer devices, *taking into account for each printer device*, parameters selected from the set:
 - availability of said printer device;
 - a sheet material type loaded onto said printer device;
 - *an ink type* loaded onto said printer device;
 - a percentage utilization of said printer device.

As shown above, the subject matter of “*ink type*” is indeed included in the originally elected group. The Office’s holding that such subject matter was not elected puzzles Applicant, as the originally elected group comprised only two claims. In any event, because claims 31-35 are directed to an elected group, Applicant submits that the withdrawal of claims 31-35 is improper and Applicant requests that the Office properly examine these claims.

Claim 36

Claim 36 recites a method of providing on-line print services, said method comprising the steps of:

- receiving at least one order for print products on-line;
- electronically distributing said at least one order to at least one print service provider facility;
- within a said print service provider facility, electronically allocating said order to at least one printer device;
- printing a print item according to said order;
- electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

- re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

Again, as depicted below in a reproduced portion of the Office Action, it appears that the Office believes that independent claim 36 does not read on the elected invention due to claim's the inclusion of "*virtual print items*".

As to claims 31-38, these claims remain withdrawn by original presentation as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The claims recite specific features such as:

- printing a print item according to said order; (claim 36)
- electronically arranging a plurality of virtual print items on at least one virtual media sheet (claim 36)
- **re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet (claim 36).**

(Office Action of 01/03/06, p. 3-4). Applicant respectfully disagrees with the Office's assertion. Applicant instead submits that examination of these claims places no serious burden on the Office, as required by MPEP 803. In fact, it appears that the Office agrees that examination of these claims lacks such a burden, as the *Office has already allegedly found "virtual print items"* in a primary reference.

To fully illustrate this point, it is necessary to inspect claims 29 (deemed elected by the Office and examined on the merits) and 36 (deemed non-elected and not examined on the merits). Both claims are reproduced below, and are adjacent to one another for easy comparison purposes (emphasis added):

29. The method as claimed in claim 10, further comprising:

electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

36. A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said order to at least one printer device;

printing a print item according to said order;

electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

First, Applicant makes reference to the non-italicized text of claim 36. Applicant submits that this portion of claim 36 is nearly *identical* to the language of claim 10, which was *originally elected*. Thus, Applicant respectfully submits that because the non-italicized portion of claim 36 nearly mirrors an originally elected claim, this portion clearly reads upon the elected invention.

Moving to the *italicized text* of claims 29 and 36, Applicant submits that these portions are *identical*, with both reciting “virtual print items”. Applicant

notes that claim 29 has been examined on the merits by the Office. Applicant thus submits that because the Office has already examined this italicized language on the merits, *no serious burden on the Office exists* in the examination of claim 36. Applicant instead submits that the Office's substantive rejection of claim 29 is an implied concession that claim 36, whose language is a combination of claims 10 and 29, reads upon the elected invention.

The Office's *substantive rejection of claim 29* is reproduced below.

As per claim 29, Blumberg discloses electronically arranging a plurality of virtual print items on at least one virtual media sheet and re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet. See for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.

(Office Action of 01/03/06). Although Applicant disagrees with the substance of the rejection, this passage confirms that the inclusion of claims 36-38 does not seriously burden the Office as is required for a proper restriction, and it proves that the Office believes the subject matter of claim 36 to read upon the elected invention. Applicant strongly asserts that a claim set cannot burden the Office when the supposedly burdensome subject matter *has already been allegedly found by the Office in a primary reference*. Applicant further submits that the Office impliedly agrees by substantively rejecting claim 29.

In sum, the non-italicized portion of claim 36 is nearly verbatim of claim 10, an originally elected claim. The remaining italicized text, meanwhile, is

completely identical to the language of claim 29. Both originally elected claim 10 as well as added claim 29 have been examined by the Office and rejected on the merits. Thus, Applicant respectfully submits that claim 36 cannot be said to pose an undue burden on the Office, nor to be aimed at a non-elected invention.

Applicant accordingly respectfully requests the Office to properly examine claims 36-38 on their merits.

Conclusion

The Office has not established that the claims are anticipated and has failed to establish a *prima facie* case of obviousness. Furthermore, the Office has improperly withdrawn some of Applicant's claims. Accordingly, Applicant respectfully requests that the rejections be overturned, the withheld claims be examined, and all the pending claims be allowed to issue.

Respectfully Submitted,

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(8) Appendix of Appealed Claims

10. (previously presented) A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and

printing said item according to said order, with said printer device, and on said particular sheet material.

27. (previously presented) The method as claimed in claim 10, wherein said particular sheet material comprises canvas.

28. (previously presented) The method as claimed in claim 10, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material.

29. (previously presented) The method as claimed in claim 10, further comprising:

electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

30. (previously presented) The method as claimed in claim 10, wherein said act of electronically allocating allocates said item to said printer device further based on a percentage utilization of said printer device.

31. (withdrawn) A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line, said at least one order having an item requiring a particular ink type;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular ink type loaded onto said printer device; and

printing said item according to said order, with said printer device, and using said particular ink type.

32. (withdrawn) The method as claimed in claim 31, wherein said particular ink type is pigment based and identified by a unique code.

33. (withdrawn) The method as claimed in claim 31, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing using said particular ink type.

34. (withdrawn) The method as claimed in claim 31, further comprising:
electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

35. (withdrawn) The method as claimed in claim 31, wherein said act of electronically allocating allocates said item to said printer device further based on a percentage utilization of said printer device.

36. (withdrawn) A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said order to at least one printer device;

printing a print item according to said order;

electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

37. (withdrawn) The method as claimed in claim 36, wherein said act of receiving at least one order for print products on-line receives said at least one order having said print item requiring a particular sheet material, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing with said particular sheet material, wherein said act of electronically allocating allocates said print item to said at least one printer device based on said at least one printer device having said particular sheet material loaded on said at least one printer device, and wherein said act of printing said print item prints said print item with said at least one printer device and on said particular sheet material.

38. (withdrawn) The method as claimed in claim 36, wherein said act of receiving at least one order for print products on-line receives said at least one order having said print item requiring a particular ink type, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing using said particular ink type, wherein said act of electronically allocating allocates said print item to said at least one printer device based on said at least one printer device having said particular ink type loaded on said at least one printer device, and wherein said act of printing said print item prints said print item with said at least one printer device and using said particular ink type.

(9) Evidence appendix. None

(10) Related Proceedings appendix. None